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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/674,908

11/07/2000

Osamu Niwa

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02/10/2004

BAKER & BOTTS

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NEW YORK, NY 10112

EXAMINER

HON, SOW FUN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/674,908

### Applicant(s)

NIWA ET AL.

### Examiner

Sow-Fun Hon

### Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/26/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/26/03</u>  | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

***Response to Amendment***

***Rejections Withdrawn***

1. The 35 U.S. C. 112, 2<sup>nd</sup> paragraph rejection of claims 3-4 in the action mailed 06/02/03 has been withdrawn due to Applicant's affirmation in the response filed 11/26/03 of the broad interpretation of the claims.
2. The 35 U.S. C. 102(b) and 103(a) rejections of claims 1-5 in the action mailed 06/02/03 has been withdrawn due to Applicant's amendment in the response filed 11/26/03.

***New Rejections***

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasse et al. as evidenced by Khanna et al. (US 6,040,392).

Gasse et al. teaches a film composed of a polyamide resin layer (A), a polyamide resin layer blend (B) of 10-60 weight % of amorphous polyamide resin and 40-90 weight % of aliphatic polyamide resin, an adhesive layer (D) (bonding layer) and a seal layer (C) (heat sealing layer) (abstract). A preferred five-layer structure is A/D/B/D/C, wherein D is a polyolefin layer (bonding layer of polyethylene or polypropylene). Total film thickness is 15 to 400  $\mu\text{m}$  (column 2, lines 10-55) which encompasses the claimed range of 15 to 35  $\mu\text{m}$ .

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The recitation "for forming a vapor deposited balloon" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, due to the optional language of intended use, the film can be used for forming other articles.

Gasse et al. teaches that prior art film prepared from polyamide blends are biaxially stretched on grounds of strength, but can then no longer be thermoformed (column 1, lines 10-40). However, when thermoforming is not used, strength from biaxial stretching does not have to be sacrificed. Thus it would have been obvious to one of ordinary skill in the art to have biaxially stretched the film in the absence of the need to use thermoforming to further process the film in order to strengthen it.

Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, it does not matter what machines are being used to produce the presently claimed biaxially oriented film.

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In specifying that the blend comprises 10-60 weight % of amorphous polyamide resin as opposed to the remaining 40-90 weight % of aliphatic polyamide resin (abstract), Gasse et al. is in essence teaching that the remaining 40-90 weight % of aliphatic polyamide resin is crystalline. This is reinforced by Gasse et al. teaching that polyamide 6 is distinctly more crystalline than a blend containing amorphous polyamide (column 1, lines 30-45). Polyamide 6 is synonymous with nylon 6, as evidenced by Khanna et al.

Khanna et al. uses the terms "nylon polymers" and "polyamides" interchangeably (column 1, lines 20-30), thus teaching that nylon 6 is synonymous with polyamide 6. Khanna et al. also teaches that the nylon (polyamide) blend provides reduced curl when coextruded with a layer of polyolefin (olefin polymer) (column 1, lines 10-20).

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasse et al. as evidenced by Khanna et al. as applied to claims 1-2 above, and further in view of Noguchi (EP 0 792 741).

Gasse et al. has been discussed above, and teaches a film which comprises a five-layer structure composed of a polyamide resin layer, a polyolefin layer, a polyamide resin layer, an adhesive resin layer and a seal layer, wherein the polyamide resin layers comprise about 70-90 wt % of crystalline nylon (polyamide 6) and about 30-5 wt % of amorphous nylon (polyamide), as evidenced by Khanna et al.

In addition, Gasse et al. teaches that the film based on polyamide and polyolefins, has good heat sealability (column 1, lines 55-65), and that the two polyamide layers are required to give elevated mechanical strength, specifically puncture resistance (column 5, lines 45-55).

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Gasse et al., however, fails to teach a metal deposited layer formed on the other side, wherein the metal deposited layer is formed on the surface of the outermost polyamide resin layer of the film.

Noguchi teaches a multilayer film used for balloons (column 1, lines 10-15) which comprises a metal deposited layer 14 (column 4, lines 1-10) formed on the surface of the outermost polyamide (nylon) base film layer 11 (column 3, lines 50-55). The deposited metal layer provides a surface for images to be printed on (column 1, lines 35-40). Therefore it would have been obvious to one of ordinary skill in the art to have provided the surface of the outermost polyamide resin layer in the multilayer film of Gasse et al. with a metal deposited layer as taught by Noguchi in order to form a balloon decorated with images. The multilayer film of Gasse et al. has good heat sealability ('262, column 1, lines 55-65), and the combination of the two polyamide layers gives elevated mechanical strength, specifically puncture resistance ('262, column 5, lines 45-55) which is important for a balloon article.

### *Response to Arguments*

6. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH  
Sow-Fun Hon

01/30/04

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

2/2/04